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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/682,644

10/08/2003

Ray Soon Waldin

20423-08297

8264

45969

7590

05/18/2006

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EXAMINER

STEELMAN, MARY J

ART UNIT

PAPER NUMBER

2191

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/682,644	<b>Applicant(s)</b> WALDIN ET AL.	
	<b>Examiner</b> Mary J. Steelman	<b>Art Unit</b> 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/04, 3/10/05, 5/9/2005, 4/26/2006</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to application received 8 October 2003. Claims 1-36 are pending.

#### ***Information Disclosure Statement***

2. IDS received 2/9/2004, 3/10/2005, 5/9/2005, and 4/26/2006 has been considered. Two references have been lined through, as the incorrect document number was provided. Due to the lengthy IDS, Examiner requests that Applicant point out any especially pertinent reference.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

Art Unit: 2191

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Independent claims 1, 4, 19, 22 are identical to claim 1 of USPN 6,651,249 with the addition of any of the following limitations:

- a virus protection software application.
- is a file from the group of file comprising : a data file ; a program file; a database file; a graphics file; an audio file; a video file.

Dependent claims, 2, 3, 5, 6, 20, 21, 23, and 24, have added any of the following limitations:

- a virus detecting routine
- a virus signature information
- at least one rule for a spam filter
- at least one rule for a firewall

Similarly, claims 7, 10, 25, and 28 are identical to claim 2 of USPN 6,651,249 with the addition of any of the above cited independent limitations. Dependent claims 8, 9, 11, 12, 26, and 27 include the above cited dependent limitations.

Similarly, claims 13, 16, 31, and 34 are identical to claim 3 of USPN 6,651,249 with the addition of any of the above cited independent limitations. Dependent claims 14, 15, 17, 18, 32, 33, 35, and 36 include the above cited dependent limitations.

Claims 1, 7, 13, 19, 25 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. USPN 6,651,249 to Waldin et al., in view of USPN 5,684,875 to Ellenberger.

Ellenberger disclosed “virus protection software application” at col. 4, line 50. It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Waldin, to include ‘virus protection software’ in a software update, as described by Waldin, because Ellenberger recognized the need to (col. 2, line 10) protect a computer against viruses, (col. 2, line 43) detecting all kinds of virus and safely diminish any incentive on the part of virus developers to construct new viruses.

Claims 2, 8, 14, 20, 26, and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. USPN 6,651,249 to Waldin et al., in view of USPN 5,684,875 to Ellenberger.

Ellenberger disclosed a ‘virus detecting routine’ at col. 4, line 50. It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Waldin, to include ‘virus protection software’ in a software update, as described by Waldin, because Ellenberger recognized the need to (col. 2, line 10) protect a computer against viruses, (col. 2,

Art Unit: 2191

line 43) detecting all kinds of virus and safely diminish any incentive on the part of virus developers to construct new viruses.

Claims 3, 9, 15, 21, 27, and 33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. USPN 6,651,249 to Waldin et al., in view of USPN 5,684,875 to Ellenberger.

Ellenberger disclosed 'virus signature information' at col. 4, line 54. "Such detection algorithms may calculate CRC polynomials and hash functions, apply cryptographic methods, and use other known methods of virus detection. They calculate fingerprints (signature information) of files..." It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Waldin, to include 'virus protection software' in a software update, as described by Waldin, because Ellenberger recognized the need to (col. 2, line 10) protect a computer against viruses, (col. 2, line 43) detecting all kinds of virus and safely diminish any incentive on the part of virus developers to construct new viruses.

Claims 5, 6 11, 12, 17, 18, 23, 24, 29, 30, 35, and 36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. USPN 6,651,249 to Waldin et al., in view of USPN 5,684,875 to Ellenberger, and further in view of USPN 5,619,648 to Canale et al..

Canale disclosed a "rule for a spam filter" and "a rule for a firewall" at col. 2, lines 6-12. "reduces the amount of junk e-mail (spam) received by a user...", "The mail filter (firewall) for a given recipient..." Col. 6, lines 1-5, "This model would be created automatically by using

Art Unit: 2191

information retrieval (IR) techniques (rules)...on all the documents created and received...” It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Waldin / Ellenberger, to include “rule for a spam filter” and “a rule for a firewall” in a software update, as described by Waldin / Ellenberger, because Canale recognized the need to (col. 1, line 61) reduce the amount of junk mail, using filters, (col. 1, line 64) to reduce a (col. 1, line 10) major annoyance in the conventional mail system. Reducing unnecessary spam limits opportunities for viruses to enter a system.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5, 6, 11, 12, 17, 18, 23, 24, 29, 30, 35, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations “comprises at least one rule for a spam filter” and “comprises at least one rule for a firewall” are not supported in the Specification.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

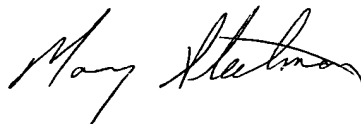
Art Unit: 2191

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman



05/10/2006